D.   REMARKS

Status of the Claims

Claims 1-26 are currently present in the Application, and claims 1, 11, and 16 are independent claims. No claims have been amended, added, or cancelled as a result of this Response.

Drawings

The Office Action did not indicate whether the formal drawings filed by the Applicant are accepted by the Examiner. Applicant respectfully requests that the Examiner indicate whether the drawings filed on April 5, 2001 are accepted by the Examiner in the next communication.

Amendments to the Specification

The specification has been amended to correct inadvertent, typographical errors.

Claim Rejections – Alleged Anticipation Under 35 U.S.C. § 102

Claims 1-2, 4-10, 16-17, and 19-26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Talmor et al., U.S. Publication No. 2003/0135740 (hereinafter Talmor). Applicant respectfully traverses the rejections under 35 U.S.C. § 102.

1. Request For New, Non-Final Office Action With Clear Citations To The Prior Art

As an initial matter, Applicant would like to draw the Examiner's attention to 37 C.F.R. § 1.104(c)(2), which states (emphasis added):

> 2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or *shows or*

PATENT

describes inventions other than that claimed by the applicant, <u>the particular part relied on</u> must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

In addition, as stated in the Manual of Patent Examining Procedure § 707.05 (emphasis added):

During the examination of an application or reexamination of a patent, the examiner should cite appropriate prior art which is nearest to the subject matter defined in the claims. *When such prior art is cited, its pertinence should be explained.*

Applicant respectfully submits that the Examiner has not followed the guidelines set forth in 37 C.F.R. § 1.104 and MPEP § 707.05. In particular, with regard to the rejection of claims 1 and 16, the Examiner has not cited any section of Talmor as disclosing particular elements of Applicant's claims (see Office Action, page 2, paragraph 2, line 7, which ends abruptly after the word "Column"). Applicant is unable to determine which particular section or sections of Talmor the Examiner is using with regard to claims 1 and 16. Also, the Examiner has not explained the pertinence of Talmor to Applicant's claims, merely stating that Talmor discloses the elements of claims 1 and 16, without giving any rationale or explanation as to why the Examiner believes this is so.

Further, the Examiner repeatedly uses column and line numbers to refer to sections of Talmor (see rejections of claims 2 and 17, claims 4 and 19, etc.). Talmor is a published application, and published applications do not have column numbers. Rather, published applications are typically referred to by page and paragraph number. It is unclear if the Examiner

Docket No. RSW920000186US1   Page 12 of 18   Atty Ref. No. IBM-R102
                                Arnold - 09/827,079

meant to refer to page numbers or was somehow assigning column numbers to the columns on each page of Talmor. Applicant is unable to determine how to correlate the column and line numbers used by the Examiner to specific page and paragraph numbers in Talmor.

Because it is difficult, if not impossible, to understand which sections of Talmor the Examiner is using in the Office Action, Applicant respectfully requests that the Examiner withdraw the present Office Action, and issue a new, non-final Office Action with clear citations to the prior art as set forth in 37 C.F.R. § 1.104 and MPEP § 707.05.

Note that Applicant's attorney attempted to call the Examiner to clear up the confusion with regard to Talmor, however, the Examiner is out of the Office until early March.

2. Talmor Does Not Teach Or Suggest Applicant's Invention As Claimed

Notwithstanding the lack of citations to specific portions of Talmor, Applicant respectfully discusses the rejections under 35 U.S.C. § 102, as best understood, below.

Applicant teaches and claims a method, system, and computer program product for using voice recognition to reset a password. A user who needs his password reset calls a help desk and reaches an automated password function. A voice recognition program asks the user to identify himself by repeating a series of random words. Once the user has been authenticated using a voice signature, the password is delivered to the user.

"To anticipate a claim, the reference must teach every element of the claim" (Manual of Patent Examining Procedure, § 2131). Talmor does not teach, or even suggest, every element of Applicant's independent claims. Importantly, Talmor does not

Docket No. RSW920000186US1   Page 13 of 18   Atty Ref. No. IBM-R102
                                    Arnold - 09/827,079

teach or suggest "delivering the password to the user in response to authenticating the user," as taught and claimed by Applicant in independent claims 1, 11, and 16. Talmor purports to teach "a system for verifying and authenticating data and the identity of the sender of the data in real time" (page 2, paragraph 0036). Biometric data, such as voice data, is used to improve the Public Key Infrastructure (PKI) as a means to verify data (page 2, paragraph 0036). However, Talmor specifically states that real time signature verification is used "in lieu of the password for the private key" (page 2, paragraph 0037). As stated by Talmor on page 3, paragraph 0060 (emphasis added) "your voice is your key—it cannot be stolen, *there is no need to protect it with passwords* or on smart cards and yet it's always with you." Because Talmor teaches away from the use of passwords, Talmor can not possibly teach or suggest "*delivering the password to the user* in response to authenticating the user," as taught and claimed by Applicant in independent claims 1, 11, and 16.

Talmor also states that "[u]se of biometrics enabling a one-time private key *instead of password-protected stored private key* (sic) is much more secure and provides a major improvement over state-of-the-art PKI" (page 8, paragraph 0164, emphasis added). Talmor is teaching away from a system that uses passwords, and is thus teaching away from Applicant's invention as claimed. In other words, Talmor teaches the use of biometrics, such as a voice print, *instead of a password*, whereas Applicant teaches and claims the use of a voice print *to retrieve a password*. Talmor does use a personal identification number (PIN) that is attached to biometric data of the user (page 6, paragraph 0129). However, Talmor states that the registration of biometric data with a user and a PIN is

Docket No. RSW920000186US1   Page 14 of 18   Atty Ref. No. IBM-R102
                                     Arnold - 09/827,079

"initiated by the administrator and not by the user" (page 6, paragraph 0129). Again, this aspect of Talmor teaches away from Applicant's invention, as claimed, because Applicant teaches and claims that the resetting of a password is under a user's control, and does not involve the use of an administrator.

Talmor does not teach or suggest every element of Applicant's independent claims. Rather, as discussed above, Talmor actually teaches away from Applicant's claims. For the reasons set forth above, Applicant respectfully submits that independent claims 1, 11, and 16, and the claims which depend from them, are patentable over Talmor, and respectfully requests that they be allowed.

Notwithstanding the patentability of independent claims 1, 11, and 16, Applicant would like to further discuss dependent claim 4, 12, and 19. Dependent claims 4, 12, and 19 add the following limitations to the independent claims:

- retrieving one or more system names in response to authenticating the user;
- receiving one or more selections from the user, wherein each selection corresponds with one of the system names; and
- delivering the passwords corresponding to the one or more selected systems to the user.

Dependent claims 4, 12, and 19 cover the situation where a user has separate passwords, each corresponding to a different system. For example, a user may have one password for his e-mail system, and another password for his on-line banking system. As taught and claimed by Applicant in claims 4, 12, and 19, the user may use his voice print to retrieve multiple passwords, each "corresponding to the one or more selected

systems." As discussed above, Talmor is concerned with the problem of verifying and authenticating data and the identity of the sender of the data (page 2, paragraph 0036). Talmor is not concerned with retrieving a password for a user, and does not teach or suggest retrieving a password for a user. Further, a careful reading of Talmor reveals no indication that Talmor ever considers or even mentions retrieving *multiple* passwords for a single user, where each password corresponds to a different system, as taught and claimed by Applicant. For the reasons set forth above, Applicant respectfully submits that claims 4, 12, and 19 are not taught or suggested by Talmor, and are thus patentable over Talmor.

Claim Rejections – Alleged Obviousness Under 35 U.S.C. § 103

Claims 3, 11-15, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Talmor in view of O'Connell, U.S. Patent No. 5,991,882 (hereinafter O'Connell). Applicant respectfully traverses the rejections under 35 U.S.C. § 103.

As discussed above, Talmor does not teach or suggest Applicant's invention, as claimed in independent claims 1, 11, and 16. O'Connell does not overcome the deficiencies of Talmor. O'Connell purports to teach an automated password reset system (see Abstract). O'Connell displays a stored question to a user, and if the user answers the question correctly, the user's password is reset (col. 1, lines 45-53). Unfortunately, as discussed by Applicant in the Background of the Invention section on page 2, lines 20-27 of their specification, the type of information used by O'Connell may be compromised. It is not unlikely that an imposter will gain access to, or be able to figure out, the stored answer. For example, one question suggested by O'Connell is "What is the name of my dog?" (col. 3,

Docket No. RSW920000186US1   Page 16 of 18   Atty Ref. No. IBM-R102
                                 Arnold - 09/827,079

PATENT

lines 16-17). This is not a very secure question and answer, as many people may know the name of the user's dog.

O'Connell does not teach or suggest any of the following elements (emphasis added) of independent claim 1 (from which claim 3 depends), independent claim 11, or independent claim 16 (from which claim 18 depends):

- *receiving a call* from the user;

- receiving one or more *spoken words* from the user;

- authenticating the received words using *a voice signature* corresponding to the user; and

- *delivering the password* to the user in response to authenticating the user.

O'Connell discloses an automated password system that works via a computer interface, not via a telephone system. O'Connell has absolutely nothing to do with authenticating a user using a voice signature. Therefore, O'Connell does not overcome the deficiencies of Talmor.

None of the prior art, either or alone or in combination, teaches or suggests Applicant's unique method, system, and computer program product for using voice recognition to reset a password. Based on the above, Applicant respectfully submits that claims 3, 11-15, and 18 are patentable, and respectfully requests that they be allowed.
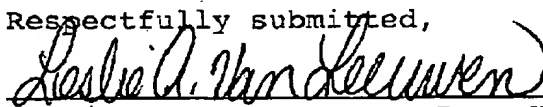
Conclusion

As a result of the foregoing, it is asserted by Applicant that the remaining claims in the Application are in condition for allowance, and Applicant respectfully requests an early allowance of such claims.

Docket No. RSW920000186US1   **Page 17 of 18**   Atty Ref. No. IBM-R102
                                    Arnold - 09/827,079

Applicant respectfully requests that the Examiner contact the Applicant's attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

By _Leslie A. Van Leeuwen_____

Leslie A. Van Leeuwen, Reg. No. 42,196
Joseph T. Van Leeuwen, Reg. No. 44,383
Van Leeuwen & Van Leeuwen
Attorneys for Applicant
Telephone: (512) 301-6738
Facsimile: (512) 301-6742

Docket No. RSW920000186US1   Page 18 of 18   Atty Ref. No. IBM-R102
                                 Arnold - 09/827,079